

REMARKS

Applicants submit this amendment in response to the Office Action dated August 9, 2004. Claims 20-30, 34, 35 and 41-45 are pending. Claims 20, 23-27, and 41 have been amended as discussed below, and no new matter is added.

Applicants acknowledge the withdrawal of certain prior rejections and objections as noted at paragraph 3, page 2 of the Office Action.

Claims 20-25 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirements. Reconsideration and withdrawal of this rejection are respectfully requested.

The Examiner states that “at least 12 contiguous nucleotides” is new matter in claim 20. Applicants first wish to note that the intent of the written description requirements is to ensure that claims have written support in an earlier application on which applicants rely for priority, not written support in the same application in which they are pending. See, for example, *In re Kraslow*, 707 F. 2d 1366, 1375. The specification supports the embodiment of “at least 12 contiguous nucleotides,” for example, at page 26, lines 25-32: “as few as about 12 nucleotides in length, usually about 14 to 18 nucleotides in length” Clearly, “as few as” is equivalent to “at least” in that both designate a lower limit of 12 and an upper limit further specified as appropriate. Without acquiescing to the rejection to the extent that it applies to claims 23-25, these claims as amended do not depend from claim 20. Withdrawal of this ground of rejection is respectfully requested.

Claims 20-30, 34-35 and 41-45 are rejected under 35 U.S.C. § 112, first paragraph, on the grounds that the specification is “non-enabling for isolated nucleic acid molecules that do not specifically bind and are only capable of if further modified such that they can then bind” (Page 3, third paragraph.) Reconsideration and withdrawal of this rejection are respectfully requested for the reasons discussed below.

The Examiner states that applicants have not taught how to further modify a nucleic acid molecule such that it binds to its target, and cites *In re Hutchison*, 69 U.S.P.Q. 138 (C.C. P.A. 1946). Applicants submit that *Hutchison* fails to support the position that the term “capable of” is not a positive limitation. Although claims 42 and 58 in *Hutchison* recite “capable of” language, they also recite “adapted” language, which is construed by the Court. However, the Court does not appear to focus on or interpret the specific phrase “capable of” anywhere in the

opinion. Applicants request that the Examiner point out the language in *Hutchison* that interprets “capable of,” as distinguished from interpretation of other claim language at issue in that case.

Furthermore, “capable of” is a widely used and accepted term in claim language. With examples too numerous to list here, a brief search of the U.S.P.T.O. database yielded 900 patents with the terms “capable of” and “polynucleotides” in the claims and 531 patents with the exact term “capable of hybridizing” in the claims. Thus, there is overwhelming precedent for such claim language, and the concept of “further modifying” a nucleic acid molecule so that it can bind to its target is not relevant. The “capable of” language refers to an intrinsic property already possessed by the claimed nucleic acid molecule. Withdrawal of this rejection is respectfully requested.

Claims 41-45 are rejected under 35 U.S.C. § 112, first paragraph, written description. As discussed above, the written description requirement was not designed to ensure an exact match of wording between an application and claims supported in that same application; instead, it related to ensuring claim support in a previous application. However, in an effort to advance the prosecution of this application, applicants have amended claim 41 to recite conditions of high stringency for hybridization, as supported in the specification at, for example, page 26, line 24.

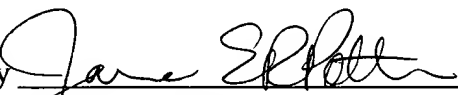
Claims 41-45 are rejected under 35 U.S.C. § 112, second paragraph, for alleged indefiniteness. Without acquiescing to the ground of rejection, claim 41 has been amended to recite that the oligonucleotide specifically hybridizes to the recited nucleic acid. This is supported in the specification, for example, at page 27, lines 25-29 (“sequences which are highly specific and form stable, duplexes with the target sequence”; “should not form . . . duplexes with other regions of DNA.”). Reconsideration and withdrawal of this rejection are respectfully requested.

Claims 20-22, 26-27, 34-35 and 41-45 are rejected under 35 U.S.C. § 102(b) as being anticipated by Smith et al. (1991), on the grounds that nucleotides 51-63 of mouse CRPB1 cDNA are 100% identical to nucleotides 1-13 of SEQ ID NO:1 of the present application. In this instance, an oligonucleotide of the sequence ATGAGAATTTCGA would not specifically bind to the nucleic acids recited in claim 20, and would be outside the scope of the claims. Applicants have therefore amended claim 20 to add the proviso that the claimed nucleic acid is not ATGAGAATTTCGA (nucleotides 1-13 of SEQ ID NO:1).

All of the claims remaining in the application are now clearly allowable. Favorable consideration and a Notice of Allowance are earnestly solicited.

If questions remain regarding this application, the Examiner is invited to contact the undersigned at (206) 206-628-7650.

Respectfully submitted,
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